

#7/11/03 at Lewis  
reconsideration  
6-17-03  
**PATENT APPLICATION**

**RESPONSE UNDER 37 CFR §1.116  
EXPEDITED PROCEDURE  
TECHNOLOGY CENTER ART UNIT 3621**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masaki KYOJIMA et al.

Group Art Unit: 3621

Application No.: 09/678,031

Examiner: D. Le

Filed: October 3, 2000

Docket No.: 107500

For: LICENSE-ISSUING SYSTEM AND METHOD

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**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the April 10, 2003 Final Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

The Office Action rejects claims 1-48 under 35 USC §103(a) as unpatentable over U.S. patent 5,892,900 to Ginter et al. (hereinafter, "Ginter"). This rejection is respectfully traversed.

The Office Action fails to establish a one-to-one correspondence between each positively recited claim feature and a corresponding feature disclosed in Ginter. Instead, the Office Action cites several different portions of Ginter and asserts that these portions collectively disclose or teach the claimed features.

This does not make out a prima facie case of obviousness, and leaves Applicants at a loss as to which disclosed feature(s) of Ginter allegedly disclose the features recited in the

claims. For example, on page 5 of the Office Action, when treating four separate clauses of claims 1 and 2, the Office Action refers to 1) the Abstract; 2) 8 separate figures; 3) text associated with the 8 separate figures; and 4) five different portions of the specification. This generalized assertion format is typical of the manner in which the Office Action is constructed.

Applicants respectfully submit that such imprecise application of the reference to the claimed invention violates Applicants fundamental procedural and substantive due process rights to an Office Action which is clearly understandable. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Under the circumstances, Applicants respectfully request that the outstanding Office Action be withdrawn and a new Office Action be prepared and mailed which explicitly points out the disclosure in Ginter that allegedly corresponds to each positively recited feature of claims 1-48.

Turning to the merits of the Office Action, as best as they are understood, Applicants present the following remarks in traversal of this rejection.

It is well settled that Applicants may be their own lexicographers. See, for example, Jonsson v. The Stanley Works, 903 F.2d 812, 819, 14 USPQ2d 1863, 1870 (Fed. Cir. 1990). In this regard, Applicants have clearly set forth definitions of key terms in their application. These definitions are found on pages 16 and 17 of the specification.

A license-issuing center is defined as a computer that generates and issues a license. The licensing issuing center accepts a request from a retailer via the Internet, and generates and issues the license.

A certificate authority is defined as a computer connected to the Internet, having a feature to generate and issue the public key certificate, storing a public key certificate issued by itself and having a feature to transmit it to a requester on demand.

A provider is defined as a provider of digital contents and/or the computer for a provider of digital contents to exchange information with a retailer and the center and is connected to the Internet.

A retailer is defined as a seller who sells digital contents to a consumer and/or a computer maintained by the seller for this purpose.

Turning to claims 1 and 2, we see that Ginter does not disclose a "license-issuing center" (1) being independent from the at least one of the provider and the seller, (2) generating verification information, (3) generating the electronic license from the license-issuing center, and (4) outputting the license.

The Office Action, for example, appears to assert that the "licensing-issuing center being independent from the at least one of the provider and the seller" is taught by "Publisher" 3308, which the Office Action, on page 4, states is "clearly separate (or independent) from any content repository or delivery system."

Actually, Publisher 3308, disclosed in conjunction with Fig. 78, would be considered to be a provider and/or a seller, not even a licensing issuance center, per se, or a licensing issuance center independent from at least one of the provider and the seller, as recited in claims 1 and 2.

The Office Action, on page 4, also discusses a rights distributor 106 in connection with Fig. 2. Column 56, lines 39-55 of Ginter, describes distributor 106 in terms of providing reports and/or payments to content creator 102, and that it may be the same as the content creator 102. In columns 57 and 58 of Ginter do not disclose or teach that rights distributor 106 is a "license-issuing center" (1) being independent from the at least one of the provider

and the seller, (2) generating verification information, (3) generating the electronic license from the license-issuing center, and (4) outputting the license.

Turning back to the basic rejection of claims 1 and 2, found in lines 1-10 on page 5 of the Office Action, the alleged motivation to set up a license-issuing center independent of all other participating entities "should there be a business reason to do so" is a fundamentally improper motivation. The use of "should there be a business reason to do so" is not only hypothetical and, therefore, finds no factual basis in Ginter, it is sheer speculation. It is well settled that a rejection must be based on facts, not speculation. As stated in In re Gpac Inc., 35 USPQ2d 1116 (Fed. Cir. 1995), "We believe that this statement by the Board in support of its rejection of claim 2 is conclusory and lacks the factual basis required to validate a claim rejection under section 103. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) ("A rejection based on section 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . [The Board] may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.")

The Office Action then discusses claims 9 and 10.

Claims 9 and 10, which recite, among other features, not only receiving a first license request, but also preparing a second license request requesting issuance of the electronic license requested in the received first license request, and outputting the second license request to the independent license-issuing center.

These features are not found in any of the cited portions of Ginter. Ginter's Abstract mentions nothing about licenses. Ginter's Figs. 1, 2, 2A, 5A-B, 14B, 77 and 78 and the associated text do not indicate "license" or "first license request" or "second license request." The "Chain of Handling and Control" disclosure cited by the Office Action actually commences and ends in column 6, and discusses "chains of parties." This is not receiving a

first license request preparing a second license request requesting issuance of the electronic license requested in the received first license request, and outputting the second license request to the independent license-issuing center. In column 10, lines 47-51, Ginter generically mentions "multiple, separate electronic arrangements" and "multiple agreements." However, this does not disclose receiving a first license request, preparing a second license request requesting issuance of the electronic license requested in the received first license request, and outputting the second license request to the independent license-issuing center. Similar comments apply to the rest of the disclosure from column 10, line 47 to column 11, line 21, which refers to "negotiations."

Column 55, line 61 to column 59, line 6 discusses what's inside information utility 200 and "rules and controls." Nothing in this section of Ginter discloses receiving a first license request, preparing a second license request requesting issuance of the electronic license requested in the received first license request, and outputting the second license request to the independent license-issuing center, as recited.

Lastly, columns 220-224 merely deal with certification keys and key pairs and fail to disclose receiving a first license request, preparing a second license request requesting issuance of the electronic license requested in the received first license request, and outputting the second license request to the independent license-issuing center, as recited.

Next, the Office Action addresses claims 16 and 17.

Claim 16 recites an agreement issuing method for allowing intermediation of a request for an electronic license for certifying that usage of digital contents is permitted to a specific user. The claim further recites inputting information to the provider to specify an intermediary who intermediates a request for an electronic license for digital contents where the license is issued by a license-issuing center which is independent from a provider of the digital contents and the intermediary, and, among other features, generating an agreement

from the provider for certifying that the intermediation of the request for the electronic license for the specified digital contents is permitted to the specified intermediary.

Claim 17 recites an agreement issuing system that issues an agreement for allowing intermediation of a request for an electronic license and recites agreement generating means and agreement output means where the agreement generating means receives information to specify an intermediary that intermediates a request for an electronic license of digital contents and information.

The Office Action indicates that most of the same portions of Ginter that were cited with respect to claims 1, 2, 9 and 10 also considered to disclose what is in claims 16 and 17. However, none of the previously cited portions of Ginter discloses the recited intermediation steps and system components that are recited in claims 16 and 17.

The Office Action additionally cites columns 269 and 270 of Ginter which are entitled "Negotiation of Contracts." In column 269, lines 42-46, Ginter states that the virtual distribution environment provides a vocabulary and mechanism by which users and creators may specify their desires and that automated processes may interpret their desires and negotiate to reach a common middle ground based on those desires. Ginter goes on to state that the results of the negotiations may be concisely described in a structure that may be used to control and enforce the results of the electronic agreement (column 269, lines 46-49). The virtual distribution environment enables the agreements to be accurately electronically described and signed to prevent repudiation (columns 269, lines 62-64) Further, a mechanism is provided by which human readable descriptions of terms of the electronic contract can be provided (columns 269, lines 64-67).

There is absolutely no disclosure in Ginter for allowing intermediation of a request for an electronic license. Instead, columns 269 and 270 deal with enablement of a specification of rights, provision of a secure processing environment within which to negotiate, provision

of a distributed environment within which rights and control specifications may be securely distributed, provision of a secure processing environment in which the negotiated contracts may be electronically rendered and signed and provision of a mechanism that securely enforces a negotiated electronic contract. This is completely different from the intermediary and intermediary features what is recited in claims 16 and 17.

Next, the Office Action addresses claims 20 and 24.

With respect to claims 20 and 24, the Office Action alleges that Ginter discloses the features recited in these claims by citing the section entitled "Examples of VDE Methods" in columns 189-206. Initially, Applicants strenuously object to the citation of eighteen columns of disclosure and requiring Applicants to ferret out that which is supposed to be anticipating the claimed invention.

Applicants note that the recited feature that information for verification and electronic license are generated from a license-issuing center where the license-issuing center is independent from at least one of the provider and the seller is not disclosed anywhere in columns 189-206. In fact, what is disclosed in columns 189-206 are high level methods typically provided for object manipulation including open method, read method, write method, close method, event method, billing method, access method, decrypt and encrypt methods, content method, extract and embed method, obscure method, fingerprint method, destroy method, panic method and meter method. The Office Action fails to make out a *prima facie* case of obviousness claims 20 and 24 because it does not indicate in any way, shape or manner how any of these methods relate to the features recited in claims 20 and 24.

The Office Action then addresses claims 21 and 25.

With respect to claims 21 and 25, the Office Action relies upon the same columns (189-206) as with respect to the rejection of claims 20 and 24. Again, the Office Action fails to make out a *prima facie* case of unpatentability of claims 21 and 25 because it completely

fails to give any indication whatsoever of how any of the methods that are disclosed in columns 189-206 render obvious the electronic license verification features that are recited in claims 21 and 25, including a license verification means in claim 25, for example, which receives an electronic license and verifies the legitimacy of the received electronic license using the information for verification stored in the verification information storage means and wherein the information for verification and the electronic license were generated from a license-issuing center and the license-issuing center is independent from the at least one of the provider and the seller.

The Office Action then addresses claims 22, 23, 27 and 29.

The rejection also fails to make out a *prima facie* case of obviousness with respect to the features recited in claims 22, 23, 27 and 29 because it completely fails to explain how the disclosure in columns 189-206 of Ginter even relates to the subject matter recited in these claims, let alone how it renders obvious all of the features recited in these claims. Moreover, since all of these claims recite that the information for verification and electronic license are generated from a license-issuing center and the license-issuing center is independent from the at least one of the provider and the seller, and such features are not disclosed at all in Ginter, for reasons set forth above, the Office Action fails to render obvious the subject matter of claims 22, 27, 23, and 29.

The Office Action then addresses claims 3, 4, 6, 7, 8, 11, 12-15, 18 and 19.

Claim 3 depends from claim 2, which is patentable over Ginter for the reasons stated above with respect to claim 2.

Claim 4 depends from claim 2 and is patentable for that reason. Additionally claim 4 recites information to specify an intermediary of the issuance of the electronic license. Ginter simply fails to specify an intermediary of the issuance of an electronic license, as explained above.



Claim 5 is patentable at least for the reasons that claim 2 is patentable, as explained above. In addition, column 20, line 42 of Ginter, relied upon by the Office Action to allegedly disclose a metering history concept, merely states that the same provider might also charge fees based on the total number of different properties licensed from them by the user and that a metering history of their licensing of properties might be required to maintain this information. However, Ginter does not disclose means for obtaining such a metering history in column 20 or in column 24, lines 24-53, which are also relied upon in this rejection.

Claim 6 depends from claim 2 and is patentable at least for the reasons that claim 2 is patentable. Furthermore, the cited portions of Ginter do not disclose a license issuance history memory unit or a request to issuance history preparing unit. Accordingly, the subject matter of claim 6 is not rendered obvious by Ginter.

Claim 7 depends from claim 2 and is patentable at least for the reasons that claim 2 is patentable over Ginter. Claim 7 further recites a verification information issuance history memory unit and a verification information issuance history preparation unit and a verification information issuance history output unit, none of which are disclosed in the text cited by the Office Action (col. 20, line 42 or col. 24, lines 24-53). Therefore, Ginter does not render obvious the features recited in claim 7.

Claim 8 depends from claim 2 is patentable for the reasons that claim 2 is patentable over Ginter.

Claim 11 depends from claim 10 and is patentable for the reasons that claim 10 is patentable.

Claim 12 depends from claim 10 and is patentable at least for the reasons that claim 10 is patentable over Ginter. In addition, claim 12 recites a license intermediation system which is simply not found in Ginter for the reasons stated above. Accordingly, claim 12 is clearly patentable over Ginter.

Claim 13 is patentable at least because it depends from claim 10 which is patentable over Ginter for the reasons stated above. Additionally, because claim 13 recites agreement storage means for storing an agreement for certifying the system is permitted to intermediate the issuance of a license, a feature which is definitely not disclosed, in any of the portions of Ginter cited with respect to claim 10, claim 13 is patentable over Ginter.

Claim 14 depends from claim 10 and is patentable at least for the reasons that claim 10 is patentable.

Claim 15 depends from claim 10 and is patentable over Ginter at least for the reasons that claim 10 is patentable.

Claim 18 depends from claim 17 and is patentable over Ginter at least for the reasons that claim 17 is patentable.

Claim 19 depends from claim 17 and is patentable over Ginter at least for the reasons that claim 17 is patentable. Additionally, because Ginter does not disclose an agreement issuance history memory unit or a history preparing unit which receives information to specify an intermediary and extracts an issuance history for the agreement, and also fails to disclose a history output unit, Ginter does not render obvious the subject matter of claim 19. More specifically, column 20, line 42 and column 24, lines 24-53 of Ginter definitely do not disclose the features relating to agreement issuance history and history output that are recited in claim 19.

Claims 26, 28 and 30 depend upon claims 25, 27 and 29, respectively and are patentable over Ginter for the reasons stated above with respect to claims 25, 27 and 29.

Claims 31, 32, 33 and 34 depend from claims 24, 25, 27 and 29, respectively, and are patentable at least for the reasons that claims 24, 25, 27 and 29 are patentable.


Claims 35-48 depend respectively from claims 1, 2, 9, 10, 16, 17, 20, 21, 22, 23, 24, 25, 27 and 29, and are patentable at least for the reasons that claims 1, 2, 9, 10, 16, 17, 20, 21, 22, 23, 24, 25, 27 and 29 are patentable.

A fair, balanced appraisal of the rejection reveals that it fails to provide enough specificity to enable Applicants to fully understand the basis of the rejection, therefore denying Applicants' procedural and substantive due process rights that they are entitled to at least under the Administrative Procedures Act. The rejection also fails to make a prima facie case of unpatentability of the claims over Ginter, for the reasons set forth above.

Accordingly, Applicants respectfully submit that all of the pending claims are patentably distinct from the Ginter reference and respectfully request that Examiner allow claims 1-48.

Should the Examiner feel that anything further is needed to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:RJW/sxb

Date: June 10, 2003

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